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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/842,219 | 04/26/2001 | Shunpei Yamazaki | 12732-032001 / US4867 | 5375 |
| 26171 | 7590 | 08/17/2004 | EXAMINER | |
| FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500 | | | HENNING, MATTHEW T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2131 | |

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/842,219 | YAMAZAKI ET AL. | |
| | Examiner | Art Unit | |
| | Matthew T Henning | 2131 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 April 2001.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-53 is/are pending in the application.
 4a) Of the above claim(s) 2-25,27-50,52 and 53 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,26 and 51 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 26 April 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5, 8</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

This action is in response to the communication filed on 04/26/2001.

DETAILED ACTION

1. Claims 1, 26, and 51 have been examined. Claims 2-25, 27-50, and 52-53 have been cancelled as per the applicant's preliminary amendment filed 04/26/2001.

Title

2. The title of the invention is acceptable.

Priority

3. The application has been filed under Title 35 U.S.C §119, claiming priority to Japanese application 2000-126513, filed April 26, 2000.

4. The effective filing date for the subject matter defined in the pending claims in this application is April 26, 2000.

Information Disclosure Statement

5. The information disclosure statements (IDS) submitted on 04/26/2001 and 03/27/2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Drawings

6. The drawings filed on 04/26/2001 are acceptable for examination proceedings.

Specification

7. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

8. Line 1: The phrase "The present invention provides" can be implied and therefore must be removed.

Lines 2-5 contain legal phraseology which must be removed.

Correction is required. See MPEP § 608.01(b).

9. The disclosure is objected to because of the following informalities:

Page 11 Line 10 should state that Figure 11 is prior art to be consistent with Figure 11 and because only that which is old is shown.

Appropriate correction is required. See MPEP § 608.01(f).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 26, and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 1 and 26 recite the limitation "the server" in line 8 of each claim. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 1, 26, and 51 recite the limitation "they" in line 7 of claims 1 and 26, and in line 9 of claim 51. The ordinary person skilled in the art would be unable to determine

to what the term “they” is referring. This is due to the fact that the limitation could be referring to the individual, to the client, to the storing means, to the reading means, to the checking means, to the read biological information, or to the stored biological information. The use of limitation “they” in these claims renders the scope of the claims indeterminate and therefore claims 1, 26, and 51 are rejected for failing to point out and distinctly claim what the applicant regards as the invention.

For purposes of searching prior art, the examiner will assume that “they” refers to the biological information that is being compared to the database.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Pare, Jr. et al. (U.S. Patent Number 5,764,789) hereinafter referred to as Pare.

16. Claim 1 recites a system for identifying an individual to identify a client, said system comprising a storing means for storing the biological information of the client (See Pare Fig. 1 Biometric Database); a reading means for reading the biological information of the client (See Pare Fig. 3 Element 12); a checking means for checking the read biological information with the stored biological information (See Pare Fig. 8 and Col. 27 Paragraph 7); a transmitting means for transmitting information that they have matched to the server in a case where the checking has matched (See Pare Fig. 9 and Col. 27 Paragraph 7).

17. Claim 26 is rejected for the same reasons as claim 1 above.

18. Claim 51 is rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (U.S. Patent Number 6,219,793) hereinafter referred to as Li.

Claim 51 recites a business method using Internet, said business method comprising: an identifying element to identify a client (See Li Fig. 1 Elements 101, 102, and 112); a control element (See Li Fig. 1 Element 106) for controlling a communication between the client (See Li Fig. 4 Element 415) and a plurality of dealers (See Li Fig. 2 Elements 202); said identifying element comprising: a reading means for reading biological information of the client (See Li Fig. 1 and Fig. 4 Element 101); a checking means for checking the read biological information (See Li Fig. 3A Step 308) with reference biological information (See Li Fig. 3A Step 309); a transmitting means for transmitting information that they have matched to the control element in a case where the checking has matched (See Li Fig. 3B Step 311); said control element comprising: an admitting means for admitting the communication between the client and the plurality

of dealers after identifying the client by the control element (See Li Fig. 3B Steps 312, 313, 320, 314, and 316); a providing means for providing a password to the client (See Fig. 3A Steps 306 and 307 wherein the challenge is the password).

Conclusion

19. Claims 1, 26, and 51 have been rejected.
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. IBM TDB ("Palm Pilot for Credit/Debit/Cash Card with Biometric Authentication") disclosed a method for authenticating transactions using a palm pilot with biometric authentication capabilities.
 - b. Ruell (U.S. Patent Number 4,532,508) disclosed a system for authenticating an individual using biometric data stored on a portable medium.
 - c. Drexler et al. (U.S. Patent Number 5,412,727) disclosed a system for voting wherein the voter was authenticated through read biometric data compared to biometric data stored in an offsite database.
 - d. Osten et al. (U.S. Patent Number 5,719,950) disclosed a biometric authentication system which multiple biometric devices verified different biometric characteristics simultaneously.
 - e. Yu et al. (U.S. Patent Number 5,930,804) disclosed a web based biometric authentication system for authorizing access to various web servers.

f. Ho (U.S. Patent number 6,021,212) disclosed a fingerprint authentication system for use with a computer in which the user was authenticated periodically via a biometric sensor on the mouse.

g. Baumann (U.S. Patent Number) disclosed a communication system in which a mobile phone authenticated the user through biometric data of the user.

21. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (703) 305-0713. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
Assistant Examiner
Art Unit 2131



AYAZ SHEIKH
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TECHNOLOGY CENTER 2100